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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/720,948
Filing Date: November 24, 2003
Appellant(s): GAGNON, PAUL R.

Barry L. Kelmachter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4 April 2008 appealing from the Office action mailed 20 September 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,320,094	ARNOLD	11-2001
4,951,658	MORGAN et al.	08-1990
4,719,909	MICCHIA et al.	01-1988

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 7-10, 15, 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (6,320,094).

Regarding claims 1 and 10, Arnold teaches an eye patch that anticipates claims 1 and 10. (see column 1, lines 7-10). Arnold teaches applying the disposable eye patch to the user's face with an adhesive layer. (see column 1, lines 7-10, Column 3, lines 34-39). Arnold's patch has a sufficient "thickness" to satisfy the claimed vision-interfering functions of independent claims 1 and 10 i.e. Arnold's patch placed over the eye of a user would interfere with the user's "ability to look at said sporting object while attempting to control said sporting object due to said thickness" for the reasons explained earlier. Arnold teaches the eye patch has first and second sheet members (11 and 12, respectively) having a thickness ranging from 0.1 mm to 5 mm (.004 to .196 inches), (see column 3, lines 39-45). As shown in Arnold's figure 3, the first and second sheets are positioned atop one another with an adhesive (13a) dispersed between them. Arnold also teaches that the first and second sheet members preferably have the same thickness. (see column 2, lines 18-19). Summing the thicknesses gives an eye patch thickness range of 0.2 to 10 mm (.008 to .292 inches). Actually, as shown in figure 3, Arnold's patch thickness will be thicker than this summed range, because of the additional thickness included by the adhesive layer 13a.

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Applicant indicates in his specification that the "thickness sufficient" to perform the various claimed vision-interference functions is "one quarter inch or more", (see page 4 of specification). From the foregoing, Arnold teaches a patch having the same thickness as Applicant's device (i.e. one quarter inch or more). Because the patch thickness disclosed by Arnold may be the same as disclosed by applicant, it is reasonable to consider Arnold's eye patch as inherently capable of performing applicant's vision-interference functions recited in claims 1 and 10.

While claim 1 refers to positioning the device beneath an individual's eye, claim 10 recites that the vision-training device is placed specifically on the cheeks under the eyes of the individual. Both claims 1 and 10 now recite that the piece of material does not cover any portion of said eye. However, the recitation in claim 1 that the device is placed beneath an individual's eye and in claim 10 that the device is placed on the cheeks is considered to be an intended use of the device. With device claims, we are concerned with the structure and functional capability of the device, not how the device is used. *See, In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)*. Arnold's patch reasonably appears to be capable of being applied, via its adhesive, on a cheek under an eye of the user. The patch, so positioned, would inherently interfere with the user's vision as claimed since the patch has the same thickness and would be at the same location as applicant's claimed device. Additionally, when the patch is so positioned it allows the piece of material to look forward and/or up.

Again as indicated above, the recited functional limitation on lines 8-10 and 13, 14 in claims 1 and 10, merely suggest intended use and does not further limit the structure of the

claimed invention. The structure of the prior art of record is capable of performing the recited intended use.

Regarding claims 2 and 15, Arnold's patch, as explained above, has the same thickness as claimed. While the positioning of the patch is considered to be an intended use, nevertheless, Arnold's patch is capable of being positioned on the face of a user such that the maximum disclosed thickness reasonably appears to be inherently capable of directing a user's vision up and toward a field of play and players thereon (claim 2), or restricting the user's peripheral vision (claim 15).

Regarding claims 7 and 8, Generally, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the substrate, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) ; In re Miller, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (C.C.P.A. 1969); MPEP § 2112.01 (Rev. 3, August 2005). Additionally, matters directed to design or ornamentation only, having no mechanical function whatsoever with respect to the claimed invention, cannot be relied on as a basis for patentability. In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (C.C.P.A. 1947). Therefore, in order for the "logo" and "written indicia" recited in claims 7 and 8 to distinguish the product from the prior art, there must be a functional relationship between the "logo" or "written indicia" and the substrate of the sports vision-training device. Mere ornamentation of the product will not impart patentability to an otherwise old product. Applying this legal principle to claims 7 and 8, it appears that the "logo" and "written indicia" limitations are mere ornamentation and are not functionally related

to the substrate. Applicant has disclosed nothing in his specification to indicate that the "logo" or "written indicia" serves any function other than ornamentation. As such, the "logo" and "written indicia" may not be relied upon for patentability.

Regarding claim 9, Arnold shows the patch is disposal (see title of the invention; also see column 1, line 7).

Regarding claim 20, as indicated above Arnold teaches that the eye patch has first and second sheet members (11 and 12, respectively) having a thickness ranging from 0.1 mm to 5 mm (.004 to .196 inches), (see column 3, lines 39-45). As shown in Arnold's figure 3, the first and second sheets are positioned atop one another with an adhesive (13a) dispersed between them. Arnold also teaches that the first and second sheet members preferably have the same thickness. (See column 2, lines 18-19). Summing the thicknesses gives an eye patch thickness range of 0.2 to 10 mm (.008 to .292 inches). Actually, as shown in figure 3, Arnold's patch thickness will be thicker than this summed range, because of the additional thickness included by the adhesive layer 13a. Applicant indicates in his specification that the "thickness sufficient" to perform the various claimed vision-interference functions is "one quarter inch or more". (See page 4 of specification). From the foregoing, Arnold teaches a patch having the same thickness as Applicant's device (i.e. one quarter inch or more).

Regarding claims 21 and 22, the recitation in claims 21 and 22 that the device is positioned such that the user ... 20 degrees relative to the user's vertical field of vision, is considered to be an intended use of the device. With device claims, we are concerned with the structure and functional capability of the device, not how the device is used. See, In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and Ex parte Masham, 2

USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Arnold's patch reasonably appears to be capable of being applied such that the user ... 20 degrees relative to the user's vertical field of vision. The patch, so positioned, would inherently interfere with the user's vision as claimed since the patch has the same thickness and would be at the same location as applicant's claimed device.

Claims 3-6, 11-14, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (6,320,094) in view of Morgan et al (4,951,658).

Regarding claims 3, 11 and 16 the aforementioned claims require that the device be constructed of an open-cell foam material. Arnold teaches that the patch is made of a "biocompatible foamed plastic material", but is silent as to the foam being open-cell. (see column 2, line 15). Morgan teaches that making an eye patch out of open-cell foam material permits moisture from perspiration and wound exudate to evaporate through sides of the foam material. (see column 2, lines 36-39). Moreover, Morgan teaches that the open cell foam material increases comfort of the user and does not cause trauma to skin (i.e. skin rash). (see column 5, lines 24 and 25; and column 3, lines 15, 16 and 21). Seemingly, it would have been prima facie obvious at the time the invention was made, to a person of ordinary skill in the art, to have combined Morgan's open-cell foam material with Arnold's biocompatible foam eye patch in view of Morgan's express teachings as to the enhanced comfort and breathability of a patch made of open-cell foam.

Regarding claims 4, 5, 13 and 17, the aforementioned claims are all directed to using an adhesive that absorbs moisture and transfers it from the individual's skin to the device so as to evaporate the moisture. Claims 4, 5, 13 and 17 require a hydrocolloid as the moisture absorbing

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material. Arnold teaches using an adhesive to attach her patch to the user. (see column 3, lines 34-39). Morgan's hydrocolloidal adhesive wicks moisture from the user's skin through the adhesive and to the open cell foam patch for evaporation therefrom. (see column 2, lines 29-39). Moreover, Morgan teaches that using such a hydrocolloidal adhesive prevents the adhesive from being weakened by sweat or other moisture and, thereby, increases the comfort of the user. (see column 4, lines 32-38, column 5, lines 24 and 25). Seemingly, it would have been prima facie obvious at the time the invention was made, to a person of ordinary skill in the art, to have used Morgan's hydrocolloidal adhesive material as the adhesive for Arnold's adhesively attached eye patch in order to increase the comfort of the user and permit the patch to adhere better to the individual's skin as taught by Morgan.

Regarding claim 6, Arnold further shows the piece of material (i.e. patch) includes an upper surface, wherein the upper surface is intermittently grooved (best seen in figures 3 and 5).

Regarding claim 12, the claimed adhesive does not require the ability to transfer moisture. As such, Arnold, alone, would teach the feature of claim 12, because Arnold teaches using an adhesive to attach the eye patch to the face of the individual. (Column 3, lines 34-39).

Regarding claim 14, see claim 6, alternatively, Arnold further shows the piece of material (i.e. patch) includes a narrow stem at the base of the adhesive (best seen in figures 3 and 5; the first sheet 11 includes recessed peripheral portions above the peripheral portions 13A of the adhesive layer 13).

Regarding claim 19, Arnold further shows the piece of material (i.e. patch) includes a narrow stem at the base of the adhesive (best seen in figures 3 and 5; the first sheet 11 includes recessed peripheral portions above the peripheral portions 13A of the adhesive layer 13).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al (4,719,909) in view of Arnold (6,320,094).

Regarding claim 18, Micchia et al provides a patch device for positioning under-eye of a user in order to absorb light, the device including at least one member having an adhesive coating (adhesive layer 13) and a thickness (see figure 2) which appears to be sufficient to interfere with the user's field of vision; the patch device is positioned on the cheek under the eye of the user in a position which does not cover any portion of the eye (see figure 1). Micchia et al in figure 2 shows the patch includes a thickness, but does not disclose expressly the particular thickness associated with the patch device. Arnold teaches an eye patch (see column 1, lines 7-10). Arnold teaches applying the disposable eye patch to a portion of the user's face with an adhesive layer. (see column 1, lines 7-10, Column 3, lines 34-39). Arnold's patch has a sufficient "thickness" to satisfy the claimed vision-interfering functions. Arnold further teaches the eye patch has first and second sheet members (11 and 12, respectively) having a thickness ranging from 0.1 mm to 5 mm (.004 to .196 inches; see column 3, lines 39-45). As shown in Arnold's figure 3, the first and second sheets are positioned atop one another (see column 2, lines 18-19). Summing the thicknesses gives an eye patch thickness range of 0.2 to 10 mm (.008 to .292 inches). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made Micchia et al's patch device with an alternative thickness as disclosed by Arnold in order to aid in reducing glare and absorbing moisture from the user's face.

(10) Response to Argument

Please note the rejection of claim 18 over Arnold '094 has been withdrawn, however the rejection of claim 18 over Micchia et al in view of Arnold has been maintained.

With regards to claim 1, appellant asserts that claim 1 is allowable because Arnold does disclose the piece of material being positioned beneath an individual's eye "without said piece of material covering any portion of the eye...". The recitation in claim 1 that the device is placed the piece of material being positioned beneath an individual's eye "without said piece of material covering any portion of the eye ... is considered to be an intended use of the device. With device claims, we are concerned with the structure and functional capability of the device, not how the device is used. *See, In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).*

With regards to claim 10, appellant asserts that claim 10 is allowable because Arnold does disclose the piece of material being positioned on a user's cheek "without said piece of material covering any portion of the eye...". The recitation in claim 10 that the device is placed on a user's cheek "without said piece of material covering any portion of the eye ... is considered to be an intended use of the device. With device claims, we are concerned with the structure and functional capability of the device, not how the device is used. *See, In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).*

Appellant further asserts that claim 10 is directed to a system for training an individual, the recitation of "a system ..." in the preamble of a claim is treated as apparatus claims.

With regards to claim 2, appellant asserts “that the device of Arnold is a medical safety device and is not intended to be used on a field of play”. Again it appears appellant is merely arguing intended use.

With regards to claims 7 and 8, appellant asserts that Arnold does not disclose indicia and/or logo. As indicated above where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the substrate, the content of the printed matter will not distinguish the claimed product from the prior art.

With regards to claim 9, appellant asserts that claim 9 is allowable for the same reasons as claim 1. Claim 9 requires the member to be disposable, Arnold clearly teaches a disposal member.

With regards to claim 15, appellant asserts that claim 15 is not anticipated by Arnold for the same reasons as claim 10. Arnold's patch, as explained above, has the same thickness as claimed. While the positioning of the patch is considered to be an intended use, nevertheless, Arnold's patch is capable of being positioned on the face of a user such that the maximum disclosed thickness reasonably appears to be inherently capable of directing a user's vision up and toward a field of play and players thereon or restricting the user's peripheral vision.

With regards to claim 20, appellant asserts that claim 9 is allowable for the same reasons as claim 1. Claim 20 requires the member having a thickness at least one quarter inch. Arnold clearly teaches the claimed thickness.

With regards to claims 21 and 22 appellant further asserts that claims 21 and 22 are not anticipated by Arnold because there is no disclosure of the piece of material being positioned so

as to enable at least a partial view of the sporting object at a point equal to or less than 20 degrees ... The member or patch of Arnold can be placed in any desired position and/or angle with respect to the face of the user. Depending on the particular manner the patch or member is placed on the user's face the angle can be altered to achieve the desired angle.

With regards to claims 3-6, 11-14, 16 and 17 appellant asserts "that these claims are allowable for the same reasons as their parent claims. The secondary reference does not cure the deficiencies of Arnold." Appellant further asserts that Arnold's patch is intended to be used in procedures where aluminum-oxide crystals are discharged ... appellant concludes that "if one were to use an open-cell foamed material, the crystals could become trapped ..." appellant further asserts that Arnold's patch is to protect the eye during procedures ... open cell foamed material would not provide the desired level of protection". A review of Arnold's patent does not confirm appellant's assertions regarding crystals could become trapped or that the open cell foamed material do not provide the desired level of protection.

The appellant appears to be arguing that one of ordinary skill in the art would have been lead away from employing Morgan's patch structure for Arnold's patch because it "could lead to crystals being trapped in the open-cell and not providing the desired level of protection for the user" and would render Arnold's patch unsuitable for its intended purpose. This argument, however, is not persuasive since it is speculative and is not supported by any objective evidence. In re DeBlauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

With regards to claims 4, 5, 12, 13 and 17 appellant asserts "that one of ordinary skill in the art would not modify Arnold's eye patch to include an adhesive layer ... allowing moisture to

be transferred to the piece of material covering the eye would increase the weight of the material ... make the patient's eye uncomfortable ...” Morgan's hydrocolloidal adhesive wicks moisture from the user's skin through the adhesive and to the open cell foam patch for evaporation therefrom. (see column 2, lines 29-39). Moreover, Morgan teaches that using such a hydrocolloidal adhesive prevents the adhesive from being weakened by sweat or other moisture and, thereby, increases the comfort of the user. Again it appears that appellant's arguments are speculative and not supported by any objective evidence.

With regards to claim 6, appellant asserts "that there is no reason to groove any portion of the upper surface of Arnold's material ..." not exactly certain how appellant has arrived at the conclusion that Arnold's material was being grooved. Claim 6 as presented merely requires a groove. The groove already exists. Arnold shows the piece of material (i.e. patch) includes an upper surface, wherein the upper surface is intermittently grooved. A groove can be interpreted as a along narrow channel or depression. When referring to figures 3 and/or 5, it can be seen that the ends of the 1st sheet member (11) form a depression.

With regards to claim 14, appellant further asserts “that there is no reason to provide Arnold's eye patch with such a stem. Again Arnold has not been modified to include a stem. Claim 14 as presented recites “said member has an upper surface and intermittently spaced grooves in said upper surface Or with a narrow stem at the base”. Therefore, the Arnold patent merely needs to have one or the other. The groove as explained in claim 6, already exists and has been defined as the ends of the 1st sheet member (11) forming a depression. As for the narrow stem, again Arnold shows a narrow stem. The stem has been taken to include the piece of

material (i.e. patch) which includes a narrow stem at the base of the adhesive (best seen in figures 3 and 5; where the first sheet 11 includes recessed peripheral portions above the peripheral portions 13A of the adhesive layer 13).

With regards to claims 16 and 17, appellant asserts "that these claims are allowable for the same reason as claim 15 ..." again appellant argues intended use.

With regards to claim 19, appellant asserts "appellant incorporates the foregoing comments about the stem given in connection with claim 14." Arnold shows a narrow stem. The stem has been taken to include the piece of material (i.e. patch) which includes a narrow stem at the base of the adhesive (best seen in figures 3 and 5; where the first sheet 11 includes recessed peripheral portions above the peripheral portions 13A of the adhesive layer 13).

With regards to claim 18, appellant asserts that claim 18 is a method of training an individual playing a sport. The method comprises the steps of providing at least one member having an adhesive coating ... and a thickness sufficient to interfere with the user's field of vision ... positioning the member on at least one cheek of a user ... The patent to Micchia et al teaches providing at least one member having an adhesive coating for positioning on at least one cheek of a user/individual, this can clearly be seen in figure 1, where the member has been positioned on the cheek of the user (also see column 2, lines 14-21). Micchia et al in figure 2 shows the member includes a thickness and as indicated it is used to place on the cheek of the user. The member disclosed by Micchia et al is disposable and has light absorbing qualities. Micchia et al does not expressly disclose the thickness of the inventive device. The Arnold patent has been used as a teaching reference that indeed adhesive layer members and/or patches having

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sufficient thickness to interfere with a user's field of vision are well known. There is nothing unobvious to modify Micchia et al to include a patch/member as taught by Arnold.

In conclusion, it appears that appellant is merely arguing intended use of the device and/or providing arguments are speculative and not supported by any objective evidence.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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